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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,602	12/12/2001	Christopher L. Adrien	ERIE-75	5540
26875 7590 09/18/2007 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202			EXAMINER HANDY, DWAYNE K	
			ART UNIT 1743	PAPER NUMBER
			MAIL DATE 09/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/021,602	Applicant(s) ADRIEN ET AL.	
	Examiner Dwayne K. Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/19/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 44-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 44-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 5 and 44-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisch in view of Tolles (4,171,866). The Examiner believes Applicant is familiar with this rejection as it was applied in the Office Action dated 6/23/06 and then upheld in the Office Action dated 8/28/06. The rejection was then removed in the Office Action dated 3/21/07 when the Examiner applied the Fisch reference alone. The rejection was never overcome by Applicant. The original rejection is below for Applicant's convenience:

Fisch discloses a device for examining a sample under magnification. The device comprises a slide substrate (20) for holding a sample specimen and a cover slip (3) for covering the sample. Fisch also discloses a thin spacer layer (23) sandwiched between the cover slip (3) and the slide (2). The space formed by the spacer layer (23) creates a circular sample chamber, in which the sample will remain during examining. See figure 1a and 1b. Fisch also discloses that the cover slip is made of glass and has a thickness of 0.1 -0.5 mm (col. 3, lines 60-61), which would provide sufficient beam stiffness and allow the reaction of adhesion forces. In use, the user drops a sample into the sample chamber and applies the cover slip to the top of the slide. When the cover slip is applied to the slide, the cover slip is affixed to the thin spacer layer. Fisch differs from the instantly claimed invention in that the spacer layer of Fisch is not taught as being "a pair of spacer segments" that extends along substantially a full length of a different one of the opposed edges.

Tolles is directed to a slide device for examining samples. Tolles describes a device comprising a slide substrate (11) for holding a sample specimen and a cover slip (13) for covering the specimen. Tolles further teaches the presence of at least two parallel spacers (12) that are raised and support the cover slip (13), creating a chamber (14) between the slide (11) and cover slip (13). In figure 3 the spacers are shown as parallel lands that extend along the full length of the cover slip. It would have been obvious to one of ordinary skill in the art to use the parallel spaced spacers of Tolles in the device of Fisch to allow the sample to be inserted into the chamber of the slide while the cover slip is attached to the slide. Such would prevent any contamination resulting from inserting the sample and having to place the cover slip on the sample already present in the chamber. With respect to claims 48-52, where particular hybridization materials to be used with the slide and cover slip are recited, the materials worked upon in an apparatus are not sufficiently limiting to impart patentability to the claims. See MPEP 2115.

The Examiner further directs Applicant to Paragraphs 5-7 of the Office Action dated 8/28/06. In these paragraphs, the Examiner provides further arguments to support the rejection involving Fisch in view of Tolles.

Response to Arguments

4. The Examiner has removed the previous rejection under Fisch as agreed upon in the Interview on 6/19/07. Fisch does not teach a pair of non-contiguous spacer segment attached to the bottom surface of the cover slip such that each of the

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segments extends substantially contiguously with a full length of a different one of the opposed edges of the cover slip. Fisch instead teaches a single spacer element (23) that encloses the hybridization chamber and extends out to and substantially along the edge of the cover slip. See Paragraph 5 of the previous Office Action and Figures 1A and 1B of Fisch.

5. The Examiner, however, is now reinstating the previous rejection of Fisch in view of Tolles. The Examiner notes that the claim as currently written simply requires a single pair of noncontiguous spacer segments attached to the cover slip ("a pair of noncontiguous spacer segments attached to the bottom surface of the cover slip, each spacer segment extending...."). This limitation can be met two single spacer strips that are not in contact. This is what Tolles teaches – see Figure 3 of Tolles.

6. The Examiner and Applicant discussed the use of the term "pair of spacer segments" in claim 5 during the interview. The Examiner noted that this was slightly unclear due to use of the term "each of the pair" in line 12. The Examiner was unsure as to how many spacer segments were required in the device at that time. Applicant has addressed this by eliminating the phrase "of the pair of". The Examiner now believes that the claim is quite clear on the spacer elements at this point. The Examiner does wish to simply note, however, that the new amended claim is broader than the previous claim.

7. Finally, the claim does not require that the hybridization chamber be substantially closed. Therefore, the Examiner submits that the rejection under Fisch in view of Tolles is again an appropriate rejection. Fisch does not teach a pair of noncontiguous spacer segments, but Tolles DOES provide this feature.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
September 4, 2007


Jill Warden
Supervisory Patent Examiner
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